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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,718	12/17/1999	JEAN-LOUIS DASSEUX	9196-018-999	9219

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EXAMINER

BORIN, MICHAEL L

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/11/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/465,718

Applicant(s)

Dasseux et al

Examiner

Michael Borin

Art Unit

1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 19, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10, 11, 56-79, and 82-88 is/are pending in the application.
- 4a) Of the above, claim(s) 10, 11, and 76-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-75, 79, and 82-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 6) <input type="checkbox"/> Other: |

Art Unit: 1631

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/19/2002 has been entered.

Status of Claims

Pursuant to amendments filed 12/19/2002, claims 20-35, 43-55, 64-66, 80, 81 are canceled. Claims 1, 56-63, 67-75, 79, 82, 83 are amended.

Upon review of the status of the claims Examiner found that claims 10, 11, which in the last two communications have been treated by applicant as canceled, have not been formally canceled. Formal cancellation of claims 10, 11 is requested.

Further, in response to restriction requirement, applicant indicates agreement to cancel claims drawn to non-elected Group I.3 drawn to peptide-lipid complexes. Formal cancellation of claims 76-78 is also requested.

Double Patenting

Claims 56-75, 79, 82-88 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent Nos.

Art Unit: 1631

6004925, 6037323, and 6265377. This double-patenting rejection of record is maintained for the reasons set forth for claims 1-13, 36-42 in Office action mailed 11/28/01 (paper #8). Applicants submitted Terminal Disclaimer over U.S. Patent Nos. 6004925, 6037323, and 6265377. However, the Disclaimer was found to be defective as it lists more inventors (six) than are actually on the record (five). Submission of a substitute Disclaimer is requested. It is noted that applicant submitted in communication of 12/19/2002 that a properly executed Terminal Disclaimed would be filed.

Claims 56-75,79, 82-88 are provisionally rejected under the judicially created doctrine of double patenting over claim 22, 26-28,57-76 of copending Application No. 09/453833 or claims 1,77-96,101. This is a provisional double patenting rejection since the conflicting claims have not yet been patented. The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, i.e. peptides comprising fragments of formula (I) as instantly claimed. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in

Art Unit: 1631

the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion.

Claims 56-75, 79, 82-88 are novel and unobvious over the prior art of record or any combination thereof. The claims will be allowed provided that Terminal Disclaimers sufficient to overcome double-patenting rejections of record are submitted.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

March 7, 2003

MICHAEL BORIN, PH.D
PRIMARY EXAMINER

mlb

